

REMARKS

Applicants have placed the claims in proper reissue format. All changes are underlined. There are no brackets as there are no deletions to the original specification or claims.

The Examiner has objected to the Reissue oath/declaration as being defective. Applicants will prepare and submit a new Reissue oath/declaration.

Claims 22-56 stand rejected under the 35 USC 251, the recapture doctrine. Applicants respectfully traverse this rejection.

The Recapture rule does not apply in the absence of evidence of an admission by the applicant regarding patentability, *In re Clement*, 131 F.3d 1464 (Fed. Cir. 1998).

The Recapture doctrine has in nearly all reported cases been applied to situations in which Applicants have cancelled or amended claims. In those situations, Courts are generally clear on what constitutes an improper recapture of subject matter during reissue. An amendment to overcome a prior art

rejection is evidence of an admission that the claim was not patentable, *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992 (Fed. Cir. 1993).

In *Clement*, the Federal Circuit left open the possibility that improper recapture may be based upon argument alone. However, analysis becomes more difficult when relative claim scope is not available to illuminate what has been surrendered, *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472 (Fed. Cir. 1998).

Not all statements made to distinguish references qualify as admissions. A contrary result would effectively mean the elimination of all reissued patents, except those based upon patents receiving rare first Office Action allowances.

There was no amendment to the claims in the response to the April 6, 1999, Office Action of application 08/990,241. Therefore, the Office must find other evidence of an admission besides claim amendments.

The statement made in that Office Action is not evidence of an admission that patentability is based upon inclusion of

"a second identification code" as the Office has suggested.

The full passage with original italics is as follows:

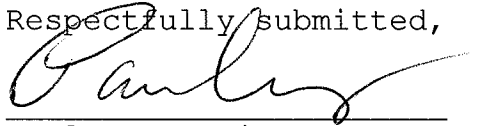
"This passage of Mergenthaler does not disclose the step of "determining a second identification code associated with a removal item *in response to a user voiding entry of the removal item*" as recited in claim 1. In fact, this passage does not relate to *voiding* any item at all. None of the merchandise items which are located in bag 60 are disclosed as being voided."

This passage serves to point out not just one, but several weaknesses in the Mergenthaler reference as anticipatory prior art. It's clear from looking at the entire passage that there is no admission that only claims containing a second identification code are patentable over the Mergenthaler reference.

The emphasis of the passage is on voiding. Even if the passage is construed as an admission, there is no recapture since claims 22-56 all include voiding.

Applicant respectfully request that the pending claims be allowed.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Paul W. Martin", written over a horizontal line.

Paul W. Martin
Attorney for Applicants
(937) 445-2990

Dayton, Ohio